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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/698,177	10/31/2003	Rex Wesley Shores	31849.42	9899
7590 J. Andrew Lowes HAYNES AND BOONE, LLP Suite 3100 901 Main Street Dallas, TX 75202-3789			EXAMINER CUMBERLEDGE, JERRY L	
			ART UNIT 3733	PAPER NUMBER
			MAIL DATE 05/15/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/698,177

**Applicant(s)**

SHORES ET AL.

**Examiner**

JERRY CUMBERLEDGE

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**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 and 16-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 16-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date 03/12/2008
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 17 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Scheller, Jr. et al. (US Pat. 4,265,231).

Scheller, Jr. et al. disclose a surgical instrument for the dissection of bone or other tissue having a motor with a power output, the surgical instrument comprising: a dissection tool (Fig. 4, ref. 16) having an elongated shaft (Fig. 4, ref. 16) with a dissection area (Fig. 5, ref. 17) disposed adjacent a distal end (Fig. 5) and a coupling area (Fig. 4, towards ref. 18) disposed adjacent a proximal end (Fig. 4), the dissection tool having a flexible portion along at least a portion of the elongated shaft (abstract); a coupling assembly configured for coupling the power output to said coupling area of said tool (Fig. 4, ref. 11A); and an angled attachment tube (Fig. 4, ref. 13) (Fig. 3) having a proximal portion for coupling to said coupling assembly (Fig. 4, near ref. 14) and an internal passage (Fig. 4) extending from said proximal portion to an opposite distal portion (Fig. 4), the attachment tube positioned along at least a portion of said elongated shaft (Fig. 4)(Fig. 3) and substantially supporting a portion of said elongated shaft disposed adjacent said dissection area (Fig. 3), said internal passage including a longitudinal curved portion (Fig. 3) disposed between said proximal portion and said distal portion (Fig. 3), said angled attachment tube supporting said elongated shaft in a

longitudinally flexed configuration corresponding to said curved portion such that the flexible portion of the dissection tool is at least partially aligned with the longitudinal curved portion of the angled attachment tube (Fig. 3), wherein said attachment tube is movably coupled to said coupling assembly (Fig. 4). The coupling assembly has a longitudinal axis (Fig. 4) and said angled attachment tube is configured for coupling with the coupling assembly at a plurality of locations (Fig. 4). The attachment tube is configured such that movement along said longitudinal axis is accomplished without substantial rotary motion (Fig. 4). The attachment tube is axially movably coupled to said coupling assembly (Fig. 4). The coupling assembly and said attachment tube include a projection and detent retention system therebetween to retain said attachment tube in said guiding position (Fig. 4)(column 3, lines 3-5). The attachment tube defines a plurality of elongated detents along an outer surface and said coupling assembly includes at least one projection for mating with said elongated detents (Fig. 4)(column 3, lines 3-5). The at least one projection may be slidably disposed in said elongated detents to permit axial movement of said attachment tube with respect to said coupling assembly (Fig. 4)(column 3, lines 3-5). The coupling assembly includes an aperture for receiving said attachment tube and at least one movable projection extending into said aperture, wherein said movable projection cooperates with said attachment tube to retain said attachment tube in the guiding position (Fig. 4)(column 3, lines 3-5). The movable projection provides a tactile sensation to the user to indicate movement between the open position and the guiding position (Fig. 4)(column 3, lines 3-5). The

elongated shaft includes a reduced diameter portion (Fig. 4). The elongated shaft includes a curved portion (Fig. 4)(Fig. 3).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5-11 and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scheller, Jr. et al. (US Pat. 4,265,231).

Scheller, Jr. et al. disclose the claimed invention except for the surgical instrument further includes a second coupling assembly linked to said coupling assembly, said second coupling assembly adapted to selectively lock said attachment tube to said coupling assembly; the second coupling assembly includes a locked position wherein said attachment tube is locked to said coupling assembly, a guiding position wherein said attachment tube is moveably coupled to said coupling assembly, and an open position wherein said attachment tube is removed from said coupling assembly. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have constructed the surgical instrument of Scheller, Jr. et al. with a second coupling assembly, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Scheller, Jr. et al. disclose the claimed invention except for the angled attachment tube having an angle of between about 3° and about 30°; the tool having a height of about 1 to about 6 inches; the tool having a diameter of about 0.02 to about 0.5 inches. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have constructed the angled attachment tube having an angle of between about 3° and about 30°; the tool having a height of about 1 to about 6 inches; and the tool having a diameter of about 0.02 to about 0.5 inches, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Claims 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scheller, Jr. et al. (US Pat. 4,265,231) in view of Wright (US Pat. 5,340,129).

Scheller, Jr. et al. disclose the claimed invention except for the motor includes a motor housing and said coupling assembly is removably coupled to the motor housing. The motor housing includes a tool chuck and said coupling assembly includes a work shaft, said work shaft removably coupled to said tool chuck. The tool chuck is moved to a locked position coupling the work shaft by rotational movement of said coupling assembly about a portion of said motor housing.

Wright discloses a motor with a housing (Fig. 1) that comprises a cutting device that comprises a tool chuck and a shaft that is removably coupled to the tool chuck (column 5, lines 52-64). The tool chuck is moved to a locked position coupling the work

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shaft by rotational movement (column 5, lines 52- 64)(Fig. 5B). The chuck system is useful in allowing components to be removably attached and secured to the device (column 3, lines 65-68)(column 4 lines 1-11), which would enable cutting elements to be interchanged if becoming dull or if a different size or type of cutting instrument is needed.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have constructed the device of Scheller, Jr. et al. with a chuck mechanism as taught by Wright in order to enable cutting elements to be interchanged if becoming dull or if a different size or type of cutting instrument is needed.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Scheller, Jr. et al. (US Pat. 4,265,231) in view of Trott (US Pat. 5,851,208).

Scheller Jr. et al. disclose the claimed invention except for the attachment tube further comprises at least one bearing proximal to the curved portion and at least one bearing distal to the curved portion to support at least a portion of the elongated shaft.

Trott discloses an angled surgical cutting device (Fig. 1)(abstract) that comprises bearing surfaces (column 5, lines 6-65), that allow for forces to be applied to the cutting element without causing its axis to deviate detrimentally from an outer tube (column 5, lines 57-60).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have constructed the device of Scheller Jr. et al. with bearing

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surfaces as taught by Trott in order to allow for forces to be applied to the cutting element without causing its axis to deviate detrimentally from an outer tube (column 5, lines 57-60).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Please see attached PTO-892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JERRY CUMBERLEDGE whose telephone number is (571)272-2289. The examiner can normally be reached on Monday - Friday, 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. C./

Examiner, Art Unit 3733

/Eduardo C. Robert/

Supervisory Patent Examiner, Art Unit 3733